

## **REMARKS**

Claims 1 and 56-58 stand rejected under § 103(a) as being obvious over U.S. Patent No. 5,442,500 to Hidano et al. (hereinafter referred to as "Hidano") in view of U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri"). Claim 56 stands rejected for indefiniteness under 35 U.S.C. § 112. Claim 57 is objected to for double patenting. Claims 7-11 are objected to as being dependent upon a rejected base claim.

As an initial matter, Applicant submits that the finality of this Office Action is inappropriate because, in accordance with the MPEP 706.07(a), second or subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims or based on information contained in an information disclosure statement filed during a period set forth in 37 CFR 1.97(c). In the present case, Applicant did not make substantive amendments to claim 1 in the previous response of February 2, 2006; nor did Applicant file an information disclosure statement with the references relied upon in making the currently pending rejection.

### **Rejections 35 U.S.C. § 112**

Claim 56 stands rejected under 35 U.S.C. § 112 for insufficient antecedent basis for "said robotic magazine transport device". Applicant has amended claim 56 herein to clarify claim 56 to delete the word "robotic." In so doing, it is not Applicant's intention to disclaim or otherwise dedicate to the public the concept of a robotic magazine transport device.

### **Double Patenting Objection**

Claim 57 stands objected to under 37 CFR 1.75 as being a substantial duplicate of claim 56. However, Applicant submits that claim 57 describes subject matter of a different scope, when compared to amended claim 56. Specifically, claim 57 currently further describes the magazine transport device of claim 56 as being robotic. As such, Applicant respectfully submits that the double patenting rejection with regard to claims 56 and 57 should be withdrawn.

### **Rejections Under 35 U.S.C. § 103**

Claim 1 stands rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri.

Obviousness under § 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). "The factual inquiry whether to combine references must be **thorough and searching**." *Id.* (emphasis added). In order to make out a *prima facie* case of obviousness, there must be an objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The motivation may come explicitly from statements in the prior art, from knowledge of one of ordinary skill in the art, or even in the nature of the problem to be solved. *Kotzab*, at 1370. The presence or absence of motivation is a question of fact, and the evidence that motivation exists must be clear and particular. *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999). Further, when the references are combined, there must be a reasonable expectation of success. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, the Examiner has failed to carry his burden of making a *prima facie* showing that one of ordinary skill in the art would have been motivated to combine Hidano and Dimitri. According to the Examiner, the only motivation for combining Hidano with Dimitri is:

One of ordinary skill in the art would have been [motivated to] modify the magazine transport device as taught by Dimitri to speed up processing.

Office Action at 3. Such a rationale is hardly "thorough and searching," especially since Hidano and Dimitri are directed entirely to solving different problems.

Hidano is directed to increasing the capacity of a storage system. Hidano purports to accomplish this by providing a "main unit 21" with racks 2a and optional "extension units 22" with more racks 2a. Hidano's storage system is a cartridge storage system that exchanges tape cartridges from outside the storage system to inside the storage system via a drawer 52 assembly that holds a magazine 30. The magazine 30 serves the purpose of performing the function of an additional rack 2a, see FIG. 5, that is not intended to be moved within the

storage system. Once loaded from the outside, the cartridges in the magazines 30 are positioned to be flush and aligned with the cartridges disposed in the racks 2a, thus functioning as "exchange racks". As shown in Hidano's FIG. 2, the magazines 30 are part of a mobile shelving rack for tapes to be exchanged for use with the storage system one at a time at the expense of speed and density. There is no suggestion in Hidano to eliminate the cartridge racks 2a in exchange for magazine racks to increase density.

On the other hand, Dimitri is directed to increasing the speed of operation of a storage system while reducing the downtime associated with the failure of "a picker and/or transport assembly." In this regard, Dimitri teaches having magazine storage bins disposed in the middle of the library with "front open sides" and "back open sides," to allow for quicker access to stored media at the deliberate expense of density and capacity. In contrast, Applicant's claimed invention is directed to storage density which can be at odds with both capacity and speed. Hence, the Examiner's assertion that one skilled in the art would have been motivated to combine the Hidano's storage system with Dimitri's magazine transport system in the interest of speed to arrive at Applicant's claimed invention is incorrect because the intent of Dimitri is blatantly at odds with the intent of Hidano.

The foregoing is confirmed in the Rule 1.132 declaration by Matthew Thomas Starr. As Mr. Starr, who is plainly one skilled in the art, attests, at the time the subject matter of the claims was invented, he would not have been motivated to combine the references as the Examiner suggests for at least the reason that the functional intent of Dimitri is at odds with Hidano. Furthermore, as Mr. Starr explains, the purpose of Hidano's magazines 30 are to function as racks 2a when loaded in the drawers 52. The result is that a major redesign of the system taught by Hidano would be required to function as a magazine library instead of a cartridge library. In addition, the nonobviousness of claim 1 is further supported when considering additional factors such as commercial success of the subject matter of those claims. Specifically, the product line embodying the subject matter has been commercially successful to the tune of sales in the tens of millions of dollars over the last three years.

For at least these reasons, Applicant respectfully submits that claim 1 is allowable over Hidano in view of Dimitri.

Claims 56-58 stand rejected for the same reasons as claim 1 and therefore, as discussed for claim 1, are not obvious over Hidano in view of Dimitri.

**Claim Objections**

According to the Office Action, claims 7-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Dependent claims 7-11 depend directly or indirectly from independent claim 1 which, as discussed above, is patentable over Hidano in view of Dimitri, and therefore applicant submits claims 7-11 are allowable as being dependent from claim 1.

\* \* \*

*Authorization To Charge Necessary Fees*

The Commissioner is hereby authorized to charge any additional necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-0289.

Respectfully submitted,

Dated: 8/28/06



Kenneth Altshuler  
Reg. No. 50,551

Correspondence Address

WALL MARJAMA & BILINSKI LLP  
101 South Salina Street, Suite 400  
Syracuse, New York 13202  
Telephone: (315) 425-9000  
Facsimile: (315) 425-9114

Customer No.: 20874

PATENT TRADEMARK OFFICE